

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q65593

Hubert HELAINE, et al.

Appln. No.: 09/918,501

Group Art Unit: 2617

Confirmation No.: 3234

Examiner: Morcos L. TORRES

Filed: August 1, 2001

For: AUTOMATIC METHOD OF MANAGING NETWORK SERVICES

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated April 4, 2008. Entry of this Reply Brief is respectfully requested.

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**STATUS OF CLAIMS**

Claims 1-16 are all of the claims currently pending in the present application. Currently, claims 1-16 stand rejected by the Examiner and are the subject of this Appeal.

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

- (1) Whether or not claims 1-2, 9 and 12-16 are unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,035,193 to Buhrmann (hereinafter “Buhrmann”), and in view of U.S. Patent No. 6,029,065 to Shah *et al.* (hereinafter “Shah”).
- (2) Whether or not claim 3 is unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, and further in view of European Patent Application No. EP 0 748 136 to Sipilä (hereinafter “Sipilä”).
- (3) Whether or not claims 4 and 6-7 are unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, in view of Sipilä, and further in view of U.S. Patent No. 6,434,399 to Kasmperschroer (hereinafter “Kasmperschroer”).
- (4) Whether or not claim 5 is unpatentable under 35 U.S.C. § 103(a) in view Buhrmann, in view of Shah, in view of Sipilä, in view of Kasmperschroer, and further in view of U.S. Patent No. 5,924,014 to Heuvel *et al.* (hereinafter “Heuvel”).
- (5) Whether or not claims 8-11 are unpatentable under 35 U.S.C. § 103(a) in view of Buhrmann, in view of Shah, and further in view of Kasmperschroer.

### **ARGUMENT**

Appellant respectfully requests the Board to reverse the above grounds of rejection *at least* for the reasons set forth in the Appeal Brief filed on January 15, 2008 (hereinafter “the Appeal Brief”). Furthermore, although Appellant believes that the Appeal Brief adequately addresses the Examiner’s position, Appellant further addresses the Examiner’s position provided in the Examiner’s Answer mailed April 4, 2008 (hereinafter “the Examiner’s Answer”), as set forth below.

#### **I. Examiner’s Objections to Summary of Claimed Subject Matter in Appeal Brief**

The Examiner’s Answer alleges that the Summary of the Claimed Subject Matter contained in the Appeal Brief is deficient because it allegedly does not provide a concise explanation of the subject matter defined in each of the independent claims involved in the Appeal. Further, the Examiner alleges that Appellant is introducing arguments in the summary of the claimed subject matter on pages 8-9.

Appellant respectfully disagrees with the Examiner’s objections. 37 C.F.R. §41.37(c)(v) requires that every appeal brief must include “[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.”

Pages 6 – 12 concisely explain the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawings, if any, by reference characters. Therefore, the Summary of the Claimed Subject

Matter contained in the Appeal Brief satisfies the requirements of 37 C.F.R. §41.37(c)(v) for *at least* these reasons.

Moreover, with regard to the Examiner's objections to pages 8-9, Appellant submits that pages 8-9 satisfy the requirements of 37 C.F.R. §41.37(c)(v) *at least* because pages 8-9 provide the required concise explanation of the subject matter defined in the independent claims involved in the appeal. For example, page 8 explains exemplary embodiments of the subject matter defined in the independent claims involved in the appeal. Further, pages 8-9 provide a concise explanation of a private base, which comprises subject matter of all of the independent claims involved in the appeal.

For *at least* these reasons, Appellant submits that the Examiner's objections with respect to the Summary of the Claimed Subject Matter contained in the Appeal Brief are improper.

## **II. Examiner's Response to Arguments that the Grounds of Rejection Fail to Show that Buhrmann, Shah, or any Combination Thereof, Teaches or Suggests The Claimed Features**

The Examiner was not persuaded by Appellant's arguments that the grounds of rejection have failed to establish even a *prima facie* case of obviousness because they have failed to demonstrate that either Buhrmann, Shah, or any combination thereof, teaches or suggests the features of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base, as claimed. In response to such arguments, the Examiner cites boilerplate caselaw language alleging that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." *See e.g.*

Examiner's Answer, page 9. Indeed, the Examiner copies and pastes this boilerplate language throughout the Examiner's Answer without substantively applying the cited caselaw to the merits of the pending arguments on appeal.

However, the boilerplate language relied upon by the Examiner is not applicable here because the facts of the cases cited by the Examiner are distinguishable from Appellant's arguments on appeal. Both cases cited by the Examiner, In re Keller, 642 F.2d 413, and In re Merck & Co., 800 F.2d 1091, rejected nonobviousness arguments relying on individual references that were considered in isolation.<sup>1</sup> In contrast, Appellant's arguments are plainly directed to Buhrmann and Shah for what they fairly teach in combination with the prior art as a whole and do not rely on consideration of these references in isolation.

For example, Appellant argues on pages 15-16 of the Appeal Brief that no combination of Buhrmann and Shah, when these references are considered with the prior art as a whole, teaches or suggests the features of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base, as claimed. In support of this position, Appellant demonstrates that Buhrmann teaches just the opposite of establishing a correspondence between service codes of two networks, as claimed, in that Buhrmann expressly teaches that the mobile operator must memorize and use the service codes that are specific to Buhrmann's private base station. See column 7, line 57 – column 8, line 10. In further support

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<sup>1</sup> See In re Keller, 642 F.2d 413, 425 (C.C.P.A. 1981); In re Merck & Co., 800 F.2d 1091, 1097 (Fed. Cir. 1986).

of this position, Appellant demonstrates that Shah teaches just the opposite of the claimed invention in that Shah expressly teaches only feature code conversion between two public base stations. (*See e.g.*, Abstract). Column 3, lines 25-53. Indeed, the Examiner's Answer fails to substantively respond to Appellant's arguments to this effect.

Since (among other reasons) both Buhrmann and Shah teach just the opposite of the claimed invention, Buhrmann and Shah, when properly considered as a whole, do not fairly teach the claimed invention in combination. In fact, as shown in Appellant's Appeal Brief, "a combination of Buhrmann and Shah would yield a wireless radio telephone, which is operative with a landline supported private base station (as taught in Buhrmann), wherein, if the wireless radio telephone visits a public base station of a public mobile telephone network (that is other than its home public base station), then the visited public base station determines what features the visiting wireless radio telephone supports and provides the feature codes that are required to access the visited network features (as taught in Shah). Appeal Brief, pages 18-19.

That is, contrary to the grounds of rejection, the combination of Buhrmann and Shah does not yield the claimed invention. Rather, one would have to further modify the combination of Buhrmann and Shah to arrive at the claimed invention—and, for *at least* the reasons discussed on pages 19-22 of the Appeal Brief, there would have been no teaching or suggestion for a skilled artisan to make such a modification.

For *at least* the aforementioned reasons, the grounds of rejection have failed to establish even a *prima facie* case of obviousness because they have failed to demonstrate that the cited references, or any combination thereof, teach or suggest the claimed invention. Thus, Appellant requests that the current rejections be reversed for *at least* these reasons.

**III. Examiner's Response to Arguments that the Public Base Stations Taught in Shah Are Fundamentally Different than the Claimed Private Base**

The Examiner was not persuaded by arguments that the public base stations taught in Shah are fundamentally different than the private base recited in claim 1 and that the claimed invention would not have been obvious for *at least* these reasons. In response, the Examiner alleges that every difference cited by Appellant has nothing to do with service codes.

As explained on pages 21-22 of Appellant's Appeal Brief, the Examiner's arguments in this regard diverge from a proper analysis under 35 U.S.C. § 103. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.<sup>2</sup> Rather than properly considering the teachings of Buhrmann and Shah as a whole, and specifically the fundamental differences that would lead a skilled artisan away from the claimed invention, the grounds of rejection effectively insert a new requirement into 35 U.S.C. § 103 that the fundamental differences between private base stations and public base stations must affect feature codes for the claimed invention to be nonobvious.

Indeed, the Examiner's allegations that Appellant has failed to mention how the fundamental differences between public and private base stations affect feature codes do not substantively respond to Appellant's arguments that both Buhrmann, Shah, and any combination thereof, fail to teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed. And, since the grounds of rejection

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<sup>2</sup> In re Newell, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).



have failed to demonstrate that the cited references, or any combination thereof, teaches or suggests the claimed invention, Appellant requests that the current rejections be reversed for *at least* these reasons.

Additionally, in response to the Examiner's contentions, Appellant reiterates that there are fundamental differences between public base stations and private base stations with respect to service codes, as would be clear to a person of ordinary skill in the art. For instance, a skilled artisan would recognize that private base stations generally have proprietary protocols and/or rich services compared to public base stations which exhibit conformance to a standard. Indeed, there is no way to develop rich services without standardization. This is why the mapping of services codes and the usage of parameters is not so easy when addressing public features with a command from private network. Such mapping is complex and indicative of a long-felt but unresolved need in the art.

Therefore, for *at least* the reasons discussed above, Appellant maintains that there are fundamental differences between public base stations and private base stations with respect to service codes, as would be clear to a person of ordinary skill in the art. Therefore, Appellant requests that the current rejections be reversed for *at least* these reasons.

**IV. Examiner's Arguments Relating to the Term "Pico Cell"**

The Examiner's arguments regarding the term "Pico cell" and the definition thereof<sup>2</sup> are irrelevant to the issues on appeal. None of the claims on appeal recite the term "Pico cell."

Further, none of the cited references include the term "Pico cell."

**V. Examiner's Response to Arguments that the Grounds of Rejection Fail to Identify the Specific Portions of either Burhmann or Shah that Teach or Suggest the Claimed Correspondence Memory**

The Examiner was not persuaded by arguments that, rather than identifying the specific portions of either Burhmann or Shah that teach or suggest the claimed correspondence memory, the grounds of rejection simply allege that it would have been obvious to combine the teachings of Burhmann and Shah and that such a combination would achieve the claimed invention. In response, the Examiner's Answer alleges that the combination of Buhrmann and Shah does arrive at the "correspondence memory" recited in claim 1 and that a skilled artisan would have been motivated to combine the teachings of Buhrmann and Shah because it would bring the same predictable result of converting the service codes as any other network. *See* Examiner's Answer, page 12.

To support the position that the combination of Buhrmann and Shah achieves the recitation of claim 1, the Examiner's Answer again relies on boilerplate caselaw language without substantively applying the cited caselaw to the merits of the pending arguments on appeal. As discussed in detail above, contrary to the recitations of claim 1, the combination of Buhrmann and Shah would yield a wireless radio telephone, which is operative with a landline

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<sup>2</sup> Examiner's Answer, page 10, lines 18-21.

supported private base station (as taught in Buhrmann), wherein, if the wireless radio telephone visits a public base station of a public mobile telephone network (that is other than its home public base station), then the visited public base station determines what features the visiting wireless radio telephone supports and provides the feature codes that are required to access the visited network features (as taught in Shah). Appeal Brief, pages 18-19.

As such, one would have to further modify the combination of Buhrmann and Shah to arrive at the recitations of claim 1—and, for *at least* the reasons discussed on pages 19-22 of the Appeal Brief, there would have been no teaching or suggestion for a skilled artisan to make such a modification and, thus, the combination of Buhrmann and Shah would not yield the same predictable result, as alleged. Therefore, Appellant requests that the current rejections be reversed for *at least* these reasons.

Additionally, Appellant vigorously disagrees with the Examiner's assertion that it would have been obvious to apply the teachings of Shah to Buhrmann's private base station since it is the same solution bringing the same predictable result of converting the service codes as any other network. Quite to the contrary, one of ordinary skill in the art would have recognized that, while some public gateways (MGC) are able to convert service codes between two public protocols, such conversion is used in the specific equipment between two public interfaces. Further, such conversion is relatively easy because the public services are the same on the two public networks attached to this gateway.

However, the situation addressed by aspects of the present invention (wherein a private network is connected to a public network) is completely different. Among other differences, private services are rich compared to public services. So, the claimed invention employs a

specific correspondence memory to assume the mapping of desired services from a private system, where services are rich, to a service code or a combined services codes on a public network. For example, to obtain a desired service with only one service code on private network it may be possible to chain two or more public services codes. An example of such issues is provided by paragraph 0041 of the specification.

One of ordinary skill in the art would recognize that, in a public domain, there is an ascending compatibility and that, when a new public protocol is defined, the protocol takes this requirement into account. So, the public gateway just makes protocol equivalence, whereas the present invention solves a long-standing but unresolved need in the art of mapping desired services from a private system, where services are rich, to a service code or a combined services codes on a public network.

Moreover, each country can use different public service codes. Accordingly, another advantage of the claimed invention is that the claimed correspondence memory can be personalized and the claimed invention can be deployed worldwide and provide associated services in a transparent manner.

Accordingly, the Examiner's allegation, that applying the teachings of Shah to Burhmann's private base station since is the same solution bringing the same predictable result of converting the service codes as any other network, is unsupported and Appellant requests that the current rejections be reversed for *at least* these reasons.

**VI. Examiner's Response to Arguments that there is No Teaching or Suggestion that the Teachings of Shah Could Be Successfully Applied to the Fundamentally Different Configuration of Buhrmann's Private Base Station**

The Examiner was not persuaded by arguments that there is no teaching or suggestion that the teachings of Shah could be successfully applied to the fundamentally different configuration of Buhrmann's private base station, much less that such teachings could be implemented between the network of a wireless radio telephone and the landline network of a private base. In response, the Examiner's Answer alleges that (1) only claim 13 discloses that the second network is a landline network, (2) none of the previously considered fundamentally different configurations affects in any way the functioning of the service codes, and (3) it would have been obvious to one of ordinary skill in the art to use the above teachings in a private base station since it would bring the same predictable result of converting the service codes as any other network.

In response to the Examiner's allegations, Appellant notes that the Examiner's indication that only claim 13 discloses that the second network is a landline network is irrelevant to Appellant's arguments that there is no teaching or suggestion to fundamentally modify the combined teachings of Buhrmann and Shah so as to develop a correspondence memory that establishes a correspondence between service codes of Buhrmann's wireless radio telephone's network (i.e., the alleged first network) and service codes of the landline network of Buhrmann's private base station (i.e. the alleged second network). Appellant invites a careful reading of pages 19-20 of the Appeal Brief, which clearly explain that the landline network mentioned in Appellant's arguments refers to the landline network of Buhrmann's private base station and not a landline network recited in Appellant's claims.

Indeed, Appellant's arguments in this regard simply rebutted the Examiner's allegations that it would have been obvious for a skilled artisan to fundamentally modify Burhmann with Shah so as to develop a correspondence memory that establishes a correspondence between service codes of Buhrmann's wireless radio telephone's network (i.e., the alleged first network) and service codes of the landline network of Buhrmann's private base station (i.e. the alleged second network). Such arguments to not rely on the feature of a landline network being recited in the pending claims and, therefore, the Examiner's indication that only claim 13 discloses that the second network is a landline network is irrelevant to the issues on appeal.

In response to the Examiner's allegations that none of the previously considered fundamentally different configurations affects in any way the functioning of the service codes, Appellant notes that the proper inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.<sup>4</sup> Here, Appellant argues that when the teachings of Buhrmann and Shah are properly considered as a whole, there is no teaching or suggestion that the teachings of Shah regarding the conversion between feature codes of two public base stations for mobile stations could be successfully applied to the fundamentally different configuration of Buhrmann's private base station, much less that such teachings could be implemented between the network of a wireless radio telephone and the landline network of a private base. Indeed, Shah's teachings are limited only to mobile stations and have nothing at all to do with private bases.

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<sup>4</sup> In re Newell, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

In response to the Examiner's allegations that it would have been obvious to one of ordinary skill in the art to use the above teachings in a private base station since it would bring the same predictable result of converting the service codes as any other network, Appellant submits that, for *at least* the reasons discussed on pages 19-22 of the Appeal Brief, there would have been no teaching or suggestion for a skilled artisan to make the proposed modification and, thus, the combination of Buhrmann and Shah would not yield the same predictable result, as alleged.

Thus, Appellant requests that the current rejections be reversed for *at least* these reasons.

**VII. Examiner's Response to Arguments that the Grounds of Rejection Fail to Provide Any Substantive Response to Appellant's Arguments of Record**

The Examiner was not persuaded by arguments that, contrary to the requirements of MPEP §707.07(f), the grounds of rejection fail to provide any substantive response to Appellant's arguments since the 10/17/07 Advisory Action simply reiterates the arguments advanced in the 07/16/07 Office Action with out substantively responding to Appellant's arguments. In response, the Examiner again cites boilerplate caselaw language without substantively applying the cited caselaw to the merits of the pending arguments on appeal.

The Examiner's Answer does not provide any response whatsoever to Appellant's arguments that Shah fails to disclose or suggest using a correspondence memory for enabling a user to move from one base station to another type of base station, as proposed by the grounds of rejection. Indeed, Shah teaches nothing more than conversion between feature codes of two public base stations (i.e., Shah teaches moving from a home network to a visited network between two base stations of the same type, namely, of the public type). Shah does not provide

any teaching or suggestion whatsoever between conversion between feature codes of base stations of different types, much less conversion between feature codes of a public base and a private base.

Accordingly, Appellant requests that the current rejections be reversed for *at least* these reasons.

**VIII. Examiner's Allegation that if Appellant Cannot Substantiate its Arguments the Arguments Moot Themselves**

The Examiner alleges that if Appellant cannot substantiate its own arguments by explaining the differences of the base stations with respect to the service codes, then the arguments moot themselves. Appellant disagrees with the Examiner's allegations in this regard.

First, Appellant has shown that, when the teachings of Buhrmann and Shah are properly considered as a whole, the fundamental differences explained in detail above would lead a skilled artisan away from the claimed invention and, thus, the claimed invention would not have been obvious in view of Buhrmann and Shah. Further, as explained above, the Examiner's requirement that the fundamental differences between private base stations and public base stations must affect feature codes for the claimed invention to be nonobvious diverges from the requirements of 35 U.S.C. § 103.

Second, Appellant amply substantiates its arguments regarding the fundamental differences between private base stations and public base stations, and why such fundamental differences render the claimed invention nonobvious, on *at least* pages 16-18 of the Appeal Brief. The Examiner has not substantively rebutted any of these arguments.



Third, the current rejections are improper regardless of how the fundamental differences between private base stations and public base stations affect feature codes. In response to arguments in this regard, page 15 of the Examiner's Answer states "interestingly in the assumption nothing had changed is still the same argument citing the base station is private. Thereby, please see the above paragraphs." This portion of the Examiner's Answer is unintelligible and Appellant assumes that the Examiner merely intended to reiterate his previous arguments. As such, Appellant maintains that the grounds of rejection should be withdrawn for *at least* the reasons already of record.

**IX. Examiner's Response to Arguments that the Grounds of Rejection Fail Because One of Ordinary Skill in the Art Would Not Have Been Motivated to Combine the Teachings of Buhrmann and Shah in the Manner Proposed**

The Examiner was not persuaded by arguments that the grounds of rejection also fail because one of ordinary skill in the art would not have been motivated to combine the teachings of Buhrmann and Shah in the manner proposed. In response, the Examiner's Answer alleges that one of ordinary skill in the art would recognize that the user wants a transparent conversion of network features and, since the dual mode mobile station of Buhrmann is designed to use private base stations, one of ordinary skill in the art would also include the use of a private base station in the correspondence memory of Shah to give transparent conversion of network features between networks.

Appellant disagrees with the Examiner's allegations and submits that they evidence classic impermissible hindsight analysis. Shah teaches that it is desirable to provide a user-transparent conversion of network feature codes in a mobile station to facilitate the mobile

station's access to a visited public mobile telephone network. Shah does not provide any motivation for a skilled artisan to establish a correspondence between service codes of a public wireless radio telephone's network and service codes of the landline network private base station, as taught in Buhrmann. Indeed, due to the fundamental differences between the public base stations taught in Shah and the claimed private base, as discussed in detail above, a skilled artisan would not have been motivated to look toward the teachings of Shah for a solution to providing a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal, and service codes of a second network, which is connected to a private base, as claimed.

As such, Appellant requests that the current rejections be reversed for *at least* these reasons.

**CONCLUSION**

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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